

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: December 29, 2004

Cancellation No. 92043766

APR NETWORK, INC.

v.

JUPITERMEDIA CORPORATION

Peter Cataldo, Interlocutory Attorney

On November 18, 2004, respondent filed its answer to the petition for cancellation and, along therewith, a motion to suspend the instant proceeding pending the outcome of a civil action between the parties herein.¹ In an order issued on December 8, 2004, the Board granted respondent's motion to extend. It has subsequently come to the Board's attention that on December 7, 2004, petitioner filed a brief in opposition to respondent's motion to suspend. In addition, petitioner, on December 1, 2004, filed a motion to expedite the instant cancellation proceeding. At the time the Board issued its December 8, 2004 order, petitioner's December 1, 2004 and December 7, 2004 submissions had not yet been associated with the instant proceeding file.

¹ Civil Action No. CV04-7578, styled *APR Network inc. v. Jupitermedia Corporation*, was filed on September 13, 2004 in the United States District Court for the Central District of California.

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In view thereof, the Board will revisit respondent's motion to suspend in order to give consideration to petitioner's above-referenced filings.

Motion to Suspend

The Board first turns to respondent's motion to suspend. The Board has carefully considered the arguments of both parties with regard to respondent's motion. However, an exhaustive review of those arguments herein would only serve to delay the Board's disposition of this matter.

It is well settled that whenever it comes to the attention of the Board that the parties to a case pending before it are involved in a civil action, proceedings before the Board may be suspended until final determination of the civil action. See Trademark Rule 2.117(a); and *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933 (TTAB 1992). Suspension of a Board case is appropriate even if the civil case may not be dispositive of the Board case, so long as the ruling will have a bearing on the rights of the parties in the Board case. See *Martin Beverage Co. Inc. v. Colita Beverage Company*, 169 USPQ 568, 570 (TTAB 1971). USPQ 861 (TTAB 1973).

In this case, the parties to the instant cancellation and Civil Action CV04-7578 are the same. Further, petitioner herein, as plaintiff in the civil action, seeks

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inter alia cancellation of the involved registration on the ground that it is merely descriptive or generic. In the instant cancellation proceeding, petitioner raises many of the same arguments as those in its civil action and seeks cancellation of the same registration on essentially the same grounds. Because the registrability of the mark involved in the cancellation proceeding is at issue before the district court in the civil action, the decision in the civil case may include a determination of registrant's rights to its involved mark. Any determination in the civil action of registrant's rights to its mark will be dispositive of, or at least have a bearing upon, the issues before the Board in this cancellation action.

Moreover, to the extent that a civil action in a Federal district court involves issues in common with those in a proceeding before the Board, the decision of the Federal district court is binding upon the Board, while the decision of the Board is not binding upon the court. *See, for example, Goya Foods Inc. v. Tropicana Products Inc.*, 846 F.2d 848, 6 USPQ2d 1950 (2d Cir.1988); and *American Bakeries Co. v. Pan-O-Gold Baking Co.*, 650 F Supp 563, 2 USPQ2d 1208 (D.Minn. 1986).

In view of the foregoing, and in the interest of judicial economy and consistent with the Board's inherent authority to regulate its own proceedings to avoid

duplicating the effort of the court and the possibility of reaching an inconsistent conclusion, **proceedings herein remain suspended** pending final disposition of the civil action between the parties.²

Within twenty days after the final determination of the civil action, the interested party should notify the Board so that this case may be called up for appropriate action. During the suspension period the Board should be notified of any address changes for the parties or their attorneys.

Motion to Expedite

The Board turns next to petitioner's motion to expedite the instant cancellation proceeding. In its motion to expedite, petitioner essentially raises the same arguments as those set forth in its brief in opposition to respondent's motion to suspend; namely, that the Board possesses expert knowledge regarding issues of trademark

² The parties will note that suspension of a Board proceeding pending the final determination of another proceeding is solely within the discretion of the Board; the court in which a civil action is pending has no power to suspend proceedings in a case before the Board, nor do parties or their attorneys. See *Opticians Ass'n of America v. Independent Opticians of America Inc.*, 734 F. Supp. 1171, 14 USPQ2d 2021 (D.N.J. 1990) (district court has no control over Board docket and no power to stay Board proceedings), *rev'd on other grounds*, 920 F.2d 187, 17 USPQ2d 1117 (3d Cir. 1990); and *Martin Beverage Co. v. Colita Beverage Corp.*, *supra*. However, if, as sometimes happens, the court before which a civil action is pending elects to suspend the civil action to await determination of the Board proceeding and the Board is so advised, the Board will go forward with its proceeding. See David B. Allen, *TIPS FROM THE TTAB: Impact of TTAB Decisions in Civil Litigation: The Alphonse-Gaston Act*, 74 Trademark Rep. 180 (1984).

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registrability; that the issues before the Board herein are highly similar to the issues before the court in the parties' civil action; and that a speedy resolution of this cancellation proceeding will allow the court to utilize the Board's decision in its adjudication of the civil action.

However, and as noted above, a Federal district court is not bound by a decision of the Board. *See Id.* Thus, expediting the instant cancellation proceeding will not provide the United States District Court for the Central District of California with a binding precedent with regard to those issues decided in this cancellation action.

Further, petitioner cites to no authority, nor is the Board aware of any, to support its position that a party may unilaterally seek expedition of a Board inter partes proceeding. It is settled that the parties to a Board inter partes proceeding may stipulate to a shortening of the discovery period. *See* Trademark Rule 2.120(a). The parties may further stipulate, under appropriate circumstances, to adjudication of the proceeding at summary judgment. *See Bausch & Lomb Inc. v. Leupold & Stevens Inc.*, 1 USPQ2d 1497 (TTAB 1986). However, absent such a stipulation submitted by both parties, neither the Trademark Rules nor applicable case law provides for expedited determination of a Board inter partes proceeding.

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In view of the foregoing, petitioner's motion to expedite the instant cancellation action is denied.

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